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52142 7590 07/21/2009 FLETCHER YODER (MICRON TECHNOLOGY, INC.) P.O. BOX 692289 HOUSTON, TX 77269-2289				
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* PAUL PETERSEN

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Appeal 2008-000770  
Application 09/419,523  
Technology Center 2100

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Decided:<sup>1</sup> July 21, 2009

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Before JAMES D. THOMAS, JOSEPH L. DIXON,  
and JEAN R. HOMERE, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

In a paper filed on June 26, 2009, Appellant requests that we rehear our decision in the opinion dated April 27, 2009, wherein we affirmed the rejections of all claims on appeal under 35 U.S.C. § 103.

Rather than consider each excerpted portion of our prior opinion in the present appeal, as individually set forth in the Request for Rehearing, we consider the issues raised by them. As separated by Appellant in the request for rehearing, the excerpts lose the context of our discussion and paragraphing of them as well as the flow of our prior opinion.

We strongly remain of the view that pages 1 through 7 of the Reply Brief set forth arguments that have been waived, since they were not presented originally in the principal Brief on appeal as indicated at the top of page 8 of the prior opinion. Additionally, Appellant has not contested at pages 12 to 13 of the principal Brief on appeal that Arai and Yoshizawa were properly combinable within 35 U.S.C. § 103, and separately did not contest as well in these pages the Examiner's reliance upon RAMBUS as being extrinsic evidence of inherency as we found at page 7 of the prior decision. The actual arguments presented for review at pages 12 and 13 of the principal Brief on appeal were aptly characterized as arguing the combination of teachings relied upon by the Examiner among the three references did not teach all the limitations of the respective independent claims on appeal. Appellant does not allege in the Request for Rehearing that we have improperly characterized the issue as set forth at page 4 of our prior decision. Pages 1 through 7 of the Reply Brief repeatedly raised the issues of lack of motivation, the lack of suggestion to combine or the like. Such arguments should have been originally made in the principal Brief on appeal. However, they were not. Therefore, they have been waived.

It bears noting here as well that Finding of Fact (“FF”) 1 on page 5 of our prior opinion in the present appeal incorporated by reference the finding of the proper combinability of Arai and Yoshizawa as expressed at pages 4 through 8 of our opinion in the earlier appeal, which we noted in the paragraph bridging pages 4 and 5 of our prior opinion in the present appeal. We went on to indicate in FF 1 additional teachings of Yoshizawa that appeared to be pertinent to the present issue before us. We did this by citing certain teachings of Yoshizawa taught operating systems software associated with the memory modules of this reference as well as the determination of the memory capacity by software and tables illustrated in exemplary Figure 3.

Significantly, the Request for Rehearing does not propose to us that the principal Brief on appeal did argue that the references were not properly combinable within 35 U.S.C. § 103. The bulk of the arguments in the Request for Rehearing consistently refer to pages of the Reply Brief that have been properly excluded from our consideration according to our prior opinion in the present appeal and here. Appellant’s positions articulated at pages 1-7 of the Reply Brief were presented in the context of an argument of the lack of combinability within 35 U.S.C. § 103 which was not properly contested in a timely manner in the principal Brief on appeal.<sup>2</sup>

Appellant has lost sight of the fact that the argued subject matter, common among independent claims 41, 54, and 62, of determining a maximum number of memory devices that “can” be supported by a memory channel or the corresponding limitation of memory device sockets that can

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<sup>2</sup> We observe that differently named practitioners in different law firms represented Appellant in the Brief and Reply Brief.

be supported, includes situations where the claimed maximum number that “can” be supported has been met by and inclusive of the teachings of the references relied upon by the Examiner. The focus of the requirements of the claims as reflected in the prior appeal related to determining memory upgrade options to expand a number of memory devices, which concept appears to be more broadly recited in the claims in the present appeal.

We included in FF2 at page 6 of our prior opinion in the present appeal the Examiner’s statements made at page 10 and 11 of the Answer, and the bulk of this portion of the Answer refers to the identified pages the Examiner found pertinent in RAMBUS. These pages included pages 40-42, 45, 56-58, and 72-75 of RAMBUS.

The paragraph bridging pages 8 and 9 of our prior opinion in the present appeal addresses the Examiner’s arguments at page 10 of the Answer that initially related to Appellant’s alleged admissions with respect to the prior art. This paragraph of our prior opinion in the present appeal clarified and limited the Examiner’s views with respect to an appropriate characterization of what Appellant actually admitted. We remain strongly of the view that the remaining portions of that paragraph indicate that Appellant has not properly addressed in the Reply Brief all the teachings the Examiner has identified among the earlier-noted pages we collectively listed in the preceding paragraph of this opinion. The same observation is made as to the Request for Rehearing. The Examiner’s reasoning and reliance upon RAMBUS merely expands in detail upon what the document teaches to an artisan and upon what Appellant has already broadly characterized (admitted was in the prior art) with respect to the memory devices of RAMBUS in the paragraph bridging pages 5 and 6 of the Specification as filed. The

Examiner established significant teachings in RAMBUS beyond what Appellant's Specification indicated to the reader.

We repeat here what we said at the middle of page 9 of our prior opinion that "on the basis of the weight of the arguments and evidence before us, the Examiner's conclusion of the obviousness of the subject matter of independent claims 41, 54, and 62 on appeal is well supported."

In view of foregoing, Appellant's Request for Rehearing is granted to the extent that we have in fact reviewed our findings, but is denied as to make any change therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

DENIED

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